

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 2801-18

BOTTAZZI et al.

C# M#

Serial No. 09/555,473

Group Art Unit: 1632

Filed: May 31, 2000

Examiner: Dhruva

Date: April 30, 2001

Title: PHARMACEUTICAL COMPOSITIONS CONTAINING THE LONG PENTRAXIN
PTX3Assistant Commissioner for Patents
Washington, DC 20231

RECEIVED

MAY 03 2001

TECH CENTER 1600/2900



Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$ 80.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$270.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s) (\$110.00/1 month; \$390.00/2 months; \$890.00/3 months) \$ 110.00

Terminal disclaimer enclosed, add \$ 110.00 \$ 0.00

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$710.00) \$ 0.00

☐ Please enter the previously unentered, filed

☐ Submission attached

Subtotal \$ 110.00

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 0.00

☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: Response; Alternate Rule 181 Petition 0.00

TOTAL FEE ENCLOSED \$ 110.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
BJS:eaw

NIXON & VANDERHYE P.C.
By Atty: B. J. Sadoff, Reg. No. 36,663

Signature: B. J. Sadoff



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Atty. Ref.: **2801-18**

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Examiner: **Dhruva**

For: **PHARMACEUTICAL COMPOSITIONS CONTAINING THE
LONG PENTRAXIN PTX3**

* * * * *

April 30, 2001

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

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RESPONSE

Responsive to the Official Action dated March 26, 2001, the applicants elect, with traverse, the subject matter of Group I for further prosecution in the above.

Withdrawal of the restriction requirement is requested as, at a minimum, the Examiner has admitted that a search of Groups III, VII and VIII would not require a search of a separate art (i.e., the subject matter of these Groups is only classified in Class 514, subclass 44). Similarly, the subject matter of Groups IV, V and VI, has been classified in Class 514, subclass 2. Accordingly, the Examiner's assertion that the subject matter of Groups IV, V and VI, at page 4 of the Office Action dated March 26, 2001 (Paper No. 6) is "unrelated" is incorrect as the Patent Office classification system is based on related subject matter. The Examiner has not specifically indicated in the comments of Paper No. 6 that the subject matter of Groups III, VII and VIII are unrelated. Withdrawal of the restriction requirement is requested as, at a minimum, the Examiner has not indicated by appropriate reliance on scientific or technical evidence

that the separately identified Groups of subject matter are distinct, such as by showing the subject matter has attained recognition in the art as a separate subject for inventive effort and that a separate field of search is required, such as may be the basis for a restriction requirement pursuant to MPEP §808.02. In fact, as noted above, the Examiner has admitted that at least Groups III, VII and VIII; and Groups IV, V and VI, contain subject matter which has not attained a separate status for inventive effort in the art. Withdrawal of the restriction requirement is requested.

More importantly, the Examiner is urged to appreciate that the present application is a U.S. national phase of PCT/IT98/00364, and that the International Preliminary Examination Report indicates that the requirement of unity of invention in accordance Rules 13.1, 13.2, and 13.3 is complied with. This is strong evidence that the restriction requirement is inappropriate.

In the event the restriction requirement is maintained, in any form, the Examiner is requested to issue a new Office Action following the requirements for U.S. national phase applications of PCT applications in justifying a lack of unity of invention and to describe how the Examiner in the European Patent Office was incorrect in determining that the requirement of unity of invention has been complied with. Such a further Office Action should be issued to allow the applicants to respond to a properly defined restriction requirement.

Finally, the Examiner is requested to rejoin the method claims, at an appropriate time, and allow the applicants an opportunity to amend the method claims as may be required, to place all the claims in condition for allowance, as allowed for in the

BOTTAZZI t al.
Serial No. 09/555,473

Commissioner's Notice published 1184 OG 86 on March 26, 1996, and the "Training Materials for the Treatment of Product and Process Claims in Light of *In re Brouwer* and *In re Ochiai* and 35 USC §103(b)", U.S. Patent and Trademark Office, Office of Patent Policy Dissemination, Patent Academy, Rev. 7/25/96.

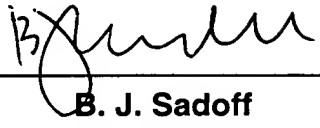
Moreover, in the event the Examiner refuses to withdraw the restriction requirement, as requested above, the Commissioner is requested to consider the attached Alternate Rule 181 Petition. The attached Alternate Rule 181 Petition is being filed to expedite prosecution and consideration of the issues contained therein. That is, in the event the Examiner refuses to withdraw the restriction requirement, as requested above, the restriction requirement will, technically, be made final. The Examiner is then requested to consider the present paper a Request for Reconsideration, as required by Rule 181, which will allow the Commissioner to consider the attached Alternate Rule 181 Petition. No fee is believed required for consideration of the attached Petition as the consideration of the attached Alternate Petition is only required due to Patent Office error in refusing to withdraw the restriction requirement, as requested above. The Office is authorized however to charge the undersigned's Deposit Account No. 14-1140 by the attached cover sheet, in the event the Commissioner deems otherwise.

Withdrawal of the restriction requirement and examination of all the pending claims are requested.

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Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
B. J. Sadoff
Reg. No. 36,663

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Arlington, VA 22201-4714
Telephone: (703) 816-4000
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